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MAR 29 2006

In re Reissue Application of
Harry O'Sullivan
Application No.: 09/835,464
Filed: April 17, 2001
Patent No. 4,697,281

: **REEXAM UNIT**
:
: DECISION TERMINATING
: PROCEEDINGS
:

This is a decision terminating proceedings in the above-identified reissue application in view of the expiration of U.S. Patent No. 4,697,281.

The above-identified application is an application for reissue of U.S. Patent No. 4,697,281 (issued on September 29, 1987).

BACKGROUND

1. Application number 06/786,641 (the '6641 application) was filed on October 11, 1985 pursuant to the provisions of 35 U.S.C. § 111.
2. Application 06/839,564 (the '9564 application) is a continuation-in-part of the '6641 application. The '9564 application was allowed on March 14, 1986, and it issued as U.S. Patent No. 4,697,281 (the '281 patent) on September 29, 1987.
3. Reissue application 09/835,464 (the '5464 reissue application) was filed on April 17, 2001. The '5464 reissue application is a divisional application of reissue application 08/436,863 which was filed on May 8, 1995 and issued on April 17, 2001 as RE 37141.
4. Reissue application 08/436,863 is a continuation of reissue application 07/930,251. Application No. 07/930,251 was filed on August 17, 1992 and is abandoned.
5. Reissue application 07/930,251 is a continuation of reissue application 07/414,468. The 07/414,468 application was filed on September 29, 1989, and it issued as RE 34034 on August 1992.
6. At the time of the mailing of this decision, the present the '5464 reissue application was being prepared for issue, at which time it was discovered that the term of the '281 patent has expired.
7. No further action has been taken in the '5464 reissue application.

DISCUSSION

35 U.S.C. § 251, first paragraph, provides that:

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

35 U.S.C. §§ 154(a)(2) and (a)(3) provide that:

(2) TERM. — Subject to the payment of fees under this title, such grant shall be for a term beginning on the date on which the patent issues and ending 20 years from the date on which the application for the patent was filed in the United States or, if the application contains a specific reference to an earlier filed application or applications under section 120, 121, or 365(c) of this title, from the date on which the earliest such application was filed.

(3) PRIORITY. — Priority under section 119, 365(a), or 365(b) of this title shall not be taken into account in determining the term of a patent.

35 U.S.C. § 154(c)(1) states:

DETERMINATION. — The term of a patent that is in force on or that results from an application filed before the date that is 6 months after the date of the enactment of the Uruguay Round Agreements Act shall be the greater of the 20-year term as provided in subsection (a), or 17 years from grant, subject to any terminal disclaimers.

MPEP § 2701 states, in pertinent part,

All patents (other than design patents) that were in force on June 8, 1995, or that issued on an application that was filed before June 8, 1995, have a term that is the greater of the "twenty-year term" or seventeen years from the patent grant. See 35 U.S.C. 154(c).

The '281 patent issued from the '9564 application. The '281 patent claimed benefit under 35 U.S.C. §§ 120 to application no. 06/786,641 filed on October 11, 1985. The '281 patent is a patent that was in force on June 8, 1995. Therefore, the term of the '281 patent was the greater of seventeen years from its issue date of September 29, 1987 or twenty years from the October 11, 1985 filing date of the '6641 application. A patent term of seventeen years from the issue date of September 29, 1987 extends through September 29, 2004, while a patent term of twenty years from the filing date of the '6641 application extends through October 11, 2005. In accordance with 35 U.S.C. § 154(c)(1) and the discussion in MPEP § 2701, the term of the '281 is the longer term, *i.e.*, twenty years measured from the October 11, 1985 filing date of the '641 application.

The United States Court of Appeals for the Federal Circuit has stated:

"[t]he language of [35 U.S.C. §] 251 is unambiguous: the [Director] has authority to reissue a patent only for the unexpired term of the original patent." (Emphasis the Court's.)

In re Morgan, 990 F.2d 1230, 1231, 26 USPQ2d 1392, 1393 (Fed. Cir. 1993) (quoting 35 U.S.C. § 251, ¶ 1). Therefore, assuming (*arguendo*) that the conditions of 35 U.S.C. § 251 were otherwise satisfied, the USPTO Director had the authority to reissue U.S. Patent No. 5,974,736 only for a term that expired on October 11, 2005 in accordance with 35 U.S.C. § 251, ¶ 1 ("the Director shall . . . reissue the patent . . . for the unexpired part of the term of the original patent.")

Since U.S. Patent No. 4,697,281 is now an expired patent, the Director no longer has authority under 35 U.S.C. § 251 to reissue U.S. Patent No. 4,697,281. *Id.* at 1231, 26 USPQ2d at 1393.

Accordingly, the proceedings in the above-identified reissue application are hereby **terminated**. See *Morgan*, 990 F.2d at 1232, 26 USPQ2d at 1393 (while 35 U.S.C. § 251 does not expressly require termination of a reissue proceeding when a patent expires, that is an inevitable concomitant of the provision that the patent can no longer be reissued).

This decision is **not** a final agency action within the meaning of 5 U.S.C. § 704. Any request for further review of this matter must be by way of a petition under 37 CFR 1.181(a)(3) filed within **TWO (2) MONTHS** from the mail date of this decision. No extension of this two-month time limit can be granted under 37 CFR 1.136(a) or (b).

Further correspondence with respect to this matter should be addressed as follows:

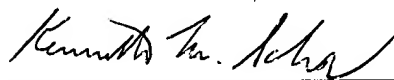
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Telephone inquiries concerning this decision should be directed to Kery A. Fries, Legal Advisor, at (571) 272-7757.

Since proceedings in the above-identified reissue application are hereby terminated, jurisdiction over the application will be retained for the two months in which any request for further review may be submitted. At that time, the application will be forwarded to Technology Center 2600 for processing as an abandoned application.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration

KF
March 29, 2006